REMARKS

Claims 1-51 are pending. By this Amendment, claims 1, 4, 9, 16, 18, 21, 26, 33, 35, 38, 43 and 50 are amended. Reconsideration based on the above amendments and the following remarks is respectfully requested.

The Examiner is thanked for the many courtesies extended to Applicants' attorney in the course of a personal interview conducted January 12, 2004. The substance of the interview is included herein per MPEP §713.04.

I.   The Claims Satisfy All Formal Requirements

The Office Action objects to claims 4, 9, 16, 21, 26, 33, 38, 43 and 50 due to informalities. Claims 4, 9, 16, 21, 26, 33, 38, 43 and 50 are amended to obviate the objection. Withdrawal of the objection of the claims is respectfully requested.

II.   The Claims Satisfy the Requirements of 35 U.S.C. §112

<u>Claims 1, 18 and 35</u>

The Office Action rejects claims 1, 18 and 35 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Office Action asserts: "The specification does not provide an adequate written description of the limitations as recited in claims 1, 18, and 35, wherein 'the conflict attributes including at least one of a policy"; therefore, it does not enable one skilled in the art to make, use and/or practice the claimed invention." This rejection is respectfully traversed.

For example, page 10, lines 3-21 provides support for "policy" as recited in claims 1, 18, and 35. Therefore, withdrawal of this rejection is respectfully requested.

Moreover, because originally filed claims 1, 18 and 35 contain the language in issue, this language is part of Applicants' original disclosure and adequate written description exists for that language. It is well settled that the claims as filed are part of the specification, and

may provide or contribute to compliance with Section 112. See <u>Northern Telecom, Inc. v.</u>

<u>Datapoint Corp.</u>, 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990) (the original

claims are part of the patent specification); <u>In re Benno</u>, 768 F.2d 1340, 1346, 226 USPQ

683, 686-87 (Fed. Cir. 1985); <u>In re Frey</u>, 166 F.2d 572, 575, 77 USPQ 116, 119 (CCPA

1948), cited in <u>Hyatt v. Boone</u>, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998).

<u>Claims 12-13, 29-30, and 46-47</u>

Claims 12-13, 29-30 and 46-47 are rejected under 35 U.S.C. §112, first paragraph, as

failing to comply with the enablement requirement. The Office Action asserts: "The

specification does not provide an adequate written description of the limitations as recited in

claims 12-13, 29-30, and 46-47, wherein checking for 'itinerary' to process a sheet according

to the at least one received job attribute; therefore, it does not enable one skilled in the art to

make, use and/or practice the claimed invention." This rejection is respectfully traversed.

For example, page 10, lines 3-21 provides support for "itinerary" as recited in claims

12-13, 29-30, and 46-47. Therefore, withdrawal of this rejection is respectfully requested.

Moreover, because originally filed claims 1, 18 and 35 contain the language in issue,

this language is part of Applicants' original disclosure and adequate written description exists

for that language. It is well settled that the claims as filed are part of the specification, and

may provide or contribute to compliance with Section 112. See <u>Northern Telecom, Inc. v.</u>

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1948), cited in <u>Hyatt v. Boone</u>, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998).

III.   <u>The Claims Define Allowable Subject Matter</u>

<u>Claims 1-2, 5-6, 10, 12-13, 18-19, 22-23, 27, 29-30, 35-36, 39-40, 44, and 46-47</u>

Claims 1-2, 5-6, 10, 12-13, 18-19, 22-23, 27, 29-30, 35-36, 39-40, 44, and 46-47 are rejected under 35 U.S.C. §102(b) as unpatentable over U.S. Patent 5,467,434 to Hower et al. ("Hower"). This rejection is respectfully traversed.

Hower does not disclose, teach or suggest "saving a user defined conflict by one of storing user specified print job attributes in a conflict list while in the save conflict mode and storing user specified conflict attributes based on the print job attributes while in the save conflict mode, the conflict attributes including at least one of a policy, a capability and a constraint," as recited in independent claim 1 from which claims 2, 5-6, 10, and 12-13 depend.

There is no disclosure in Hower of "saving a user defined conflict" nor is there any disclosure in Hower of a "save conflict mode." The Office Action asserts that a "save conflict mode" is met by "finishing option conflict rules, Fig. 13, col. 7, lines 55-67." The quoted section of Hower states:

> Each printer profile may include a printer finishing options
> availability and conflicts section and each of these sections
> preferably includes a set of keywords or parameters associated
> with finishing capabilities of a particular printer family. In
> particular, each section includes information regarding whether
> specific finishing options are enabled, and a list of rules
> associated with each value of a printer finishing option keyword.
> The list of rules associated with each keyword may include one
> or more rules couched in the form of range rules. As mentioned
> above, range rules can be used in the media description parameter
> section of a given printer profile.

Applicants respectfully submit that the Office Action does not explain how this quoted language from Hower constitutes a "save conflict mode." Further, the Office Action does not explain how this quoted language relates to the recited feature of "saving a user defined conflict." Applicants respectfully submit that Hower simply does not disclose "a save conflict mode" or "saving a user defined conflict."

Hower simply does not disclose, teach or suggest "one of a module to store user specified print job attributes in a conflict list while in the save conflict mode and a module to store user specified conflict attributes based on the print job attributes while in the save conflict mode, the conflict attributes including at least one of a policy, a capability and a constraint," as recited in independent claims 18 and 35 from which claims 19, 22-23, 27, 29-30, 36, 39-40, 44, and 46-47 depend.

The Office Action asserts that Hower discloses the claimed "conflict attributes" at column 7, lines 55-56. However, Hower only discloses a printer profile including a conflicts section, which is based on the capabilities of the printer. The printer profile 44 is composed of three segments: (1) a set of descriptions of printing media suitable for use with a printer; (2) a set of rules describing the allowed ranges and interactions between the media description parameters for the printer; and (3) a set of rules which describe the finishing and output capabilities of the printer (col. 5, lines 10-21). Therefore, Hower discloses storing a printer profile, which is directed toward the actual physical capabilities of a printer.

However, Hower does not disclose storing user specified conflict attributes, wherein the user specified conflict attributes include at least one of a policy, a capability and a constraint. Instead, Hower simply discloses a printer profile directed toward the actual physical capabilities of the printer.

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 3-4, 8-9, 15-16, 20-21, 25-26, 32-33, 37-38, and 42-43

Claims 3-4, 8-9, 15-16, 20-21, 25-26, 32-33, 37-38, and 42-43 are rejected under 35 U.S.C. §103(a) as unpatentable over Hower in view of U.S. Patent 6,166,826 to Yokoyama. This rejection is respectfully traversed.

Hower and Yokoyama, taken separately or in combination, do not disclose, teach or suggest "saving a user defined conflict by one or storing user specified print job attributes in a conflict list while in the save conflict mode and storing user specified conflict attributes based on the print job attributes while in the save conflict mode, the conflict attributes including at least one of a policy, a capability and a constraint, as recited in claim 1 from which claims 3-4, 8-9, and 15-16 depend, for reasons stated above.

Hower and Yokoyama, taken separately or in combination, do not disclose, teach or suggest "one of a module to store user specified print job attributes in a conflict list while in the saved conflict mode and a module to store user specified conflict attributes based on the print job attributes while in the save conflict mode, the conflict attributes including at least one of a policy, a capability, and a constraint," as recited in claims 18 and 35 from while claims 20-21, 25-26, 37-38 and 42-43 depend.

As stated in the Office Action, "Hower's module of a printer does not include a module to recognize a user initiated save conflict mode command." Yokoyama discloses adding a function code to print data, wherein the function code indicates that a storage specification for storing a print data is set if a user requests storage of print data. However, Yokoyama does not disclose, teach or suggest the storage of "user specified conflict attributes …the conflict attributes including at least one of a policy, a capability and a constraint," as recited in claims 1, 18 and 35 from which claims 3-4, 8-9, 15-16, 20-21, 25-26, 32-33, 37-38, and 42-43 depend. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 7, 11, 14, 17, 24, 31, 34, 41, 45 and 48-51

The Office Action rejects claims 7, 11, 14, 17, 24, 31, 34, 41, 45 and 48-51 as unpatentable over Hower in view of U.S. Patent 6,335,795 to Neuhard et al. ("Neuhard") and U.S. Patent 5,260,805 to Barrett. This rejection is respectfully traversed.

As pointed out above, Hower does not disclose, teach or suggest, "saving a user defined conflict by one of storing user specified print job attributes in a conflict list while in the save conflict mode and storing user specified conflict attributes based on the print job attributes while in the save conflict mode, the conflict attributes including at least one of a policy, a capability and a constraint," as recited in claim 1 from while claim 7, 11, 14 and 17 depend, for reasons stated above.

Hower does not disclose, teach or suggest "one of a module to store user specified print job attributes in a conflict list while in the save conflict mode and a module to store user specified conflict attributes based on the print job attributes while in the same conflict mode, the conflict attributes including at least one of a policy, a capability and a constraint," as recited in claims 18 and 35 from which claims 24, 31, 34, 41, 45 and 48-51 depend.

Neuhard or Barrett do not disclose, teach or suggest the features missing from Hower.

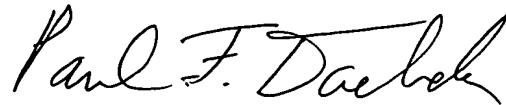Accordingly, withdrawal of this rejection is respectfully requested.

For at least these reasons, it is respectfully submitted that independent claims 1, 18 and 35 are distinguishable over the applied art. The remainder of the claims depend from independent claims 1, 18 and 35 are likewise distinguishable over the applied art for at least the reasons discussed above, as well as for the additional features they recite.

IV.   Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-51 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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JAO:PFD/can

Date: January 16, 2004

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